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REMARKS

Applicants hereby file this Amendment After Final Rejection Responsive to the Final Rejection mailed on September 22, 2006 ("Final Rejection"). Claims 15, 17, 21, 55-58, 64, 65 and 68-76 are pending. Claims 15, 21 and 55 have been amended in response to the Examiner's objections regarding form. No new matter has been added by way of these amendments.

Claims 15, 17, 21, 55-58, 64 and 65 have been rejected under 35 U.S.C. § 112, first paragraph. *See* Final Rejection at ¶ 5. Claims 15, 17 and 55 have been rejected as allegedly unpatentable under 35 U.S.C. § 103(a) over USPN 5,933,816 to Zeanah *et. al.* ("Zeanah") in view of USPN 6,012,048 to Gustin ("Gustin"), USPN 5,819,236 to Josephson ("Josephson") and USPN 5,930,778 to Geer ("Geer"). *See* Final Rejection at ¶ 7. Claims 21, 56-58, 64, 65 and 68-76 have been rejected as allegedly unpatentable under 35 U.S.C. § 103(a) over Josephson and Gustin in view of Geer. *See* Final Rejection at ¶ 9.

I.   Objections to the Claims.

The Examiner has objected to claims 15, 21 and 55 on the basis of informalities. *See* Final Rejection at ¶ 3. Applicants have amended claims 15, 21 and 55 in accordance with these objections, and respectfully request that these objections be withdrawn. Applicants note that these claim amendments do not affect the scope of the claims prior to amendment.

II.   Rejection under 35 U.S.C. § 112, first paragraph.

The Examiner has maintained the rejection of claims 15, 17, 21, 55-58, 64 and 65 under 35 U.S.C. § 112, first paragraph for allegedly failing to comply with the enablement requirement. *See* Final Rejection at ¶ 5. Specifically, the Examiner states that the basis for this rejection is that "it is unclear in the Specification that the ACH and automated banking system do not receive the physical check." *Id.* Applicants submit that a distinction should be made between **depositing the physical check, and depositing the discrete value of a physical check.** In the claimed inventions, it is the **discrete value of a physical check that is deposited.** The methods and systems of the invention accomplish this without receipt of the **physical check** by having the BOFD receive **data** regarding the physical check from the customer, **rather than the physical**

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check itself, and completing the deposit transaction **based upon the received data.**

Applicants previously noted six different sections of the Specification that describe the claimed inventions where the **value** of a conventional check is deposited from a Remote Customer Terminal ("RCT") **without physical receipt of the conventional check by the ACH or the automated banking system (bank of first deposit, or "BOFD")**. When read in light of the distinction between **deposit of the discrete value of a check** rather than **deposit of the physical check itself,** Applicants respectfully submit that enablement of the claimed inventions is clear:

1.   **Summary of the Invention:** The Summary of the Invention discloses an embodiment where a RCT "accepts" third party paper checks for deposit, **the RCT being located at the customer's home.** *See* Specification, p. 3, line 22 to p. 4, line 5. The **image of the third party paper check is captured on a scanner, and is forwarded to the BOFD system.** *See* Specification, p. 4, lines 8-9. The BOFD provides immediate provisional credit to the customer, and **forwards the *"check image and other data* to a clearing house in the form of an ECP transaction . . . [o]nce the transaction has cleared the paying bank, the BOFD issues a permanent credit to the bank customer."** *See* Specification, p. 4, lines 10-13 (emphasis added). **In this embodiment, the customer provides an image and/or data of the third party check, not the physical check itself, to the BOFD to complete the deposit transaction.**

2.   **Detailed Description of the Invention:** The Detailed Description of the Invention discloses that the **customer enters data into a RCT** comprising customer identification, customer account number, name of payor, name and routing number of payor's bank, the amount of the check, an image of the check and other information. *See* Specification, p. 8, lines 9-12. The *data* **are submitted to the BOFD for processing.** *See* Specification, p. 8, lines 13-15. **In this embodiment, the deposit transaction does not require that the BOFD or ACH physically receive the third party check.**

3.   **Detailed Description of the Invention:** The Detailed Description of the Invention discloses that the **BOFD receives transaction data** from a customer concerning a

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third party check, and the BOFD may issue credit based upon the data. *See* Specification, p.
9, lines 7-14.

4.   **Actions Taken to Prevent Re-Deposit of the Physical Check:** The Detailed
Description of the Invention discloses several different "actions" that can be taken by a
**customer to "prevent re-deposit of the same paper check" while the value of the check has
been deposited into the customer's account.** *See* Specification, p. 8, lines 19-20; p. 9, lines 14-
16; original claims 19, 20, 28, 29. One such action is that the paper check may be marked by the
RCT or physically captured by the RCT. *See* Specification, p. 8, line 20 to p. 9, line 2. After the
third party check has been deposited, these actions insure that the customer, **who retains
physical possession of the third party paper check,** cannot "re-deposit" it. **This disclosure of
"actions" to prevent re-deposit of the same check confirms that the paper check is *not*
presented to the BOFD for deposit.** If the third party check *had* been physically presented to
the BOFD for deposit, then actions to prevent "re-deposit of the same check" such as physical
capture of the check or marking by human or machine-readable ink **could not be taken.** To the
extent that the Examiner states that claims 15, 17, 21, 55-58, 64 and 65 do not disclose or claim
"actions are taken to prevent re-deposit of the same check" (Final Rejection at ¶ 10, Issue No. 1),
Applicants submit that this disclosure is cited as support for enablement of the inventions and
specifically enablement of the limitation that the ACH and automated banking system do not
receive the physical check.

5.   The Specification discloses methods for "clearing" the third party check which
confirm that the BOFD does not have physical possession of the paper check. In one such
method, the BOFD may "print a reconstructed check" which may be physically routed to the
paying bank for payment. *See* Specification, p. 9, line 18 to p. 10, line 7; original claim 24.
**There is no need to "print a reconstructed check" if the BOFD already has physical
possession of the third party check that was deposited by the customer.**

6.   **Background of the Invention:** Finally, the Background of the Invention
discloses that EFT and ECP are "existing systems that perform electronic banking. transactions"
but "are either not equipped to handle paper checks, are configured only for bank-to-bank

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transactions, or do not accept third party checks for deposit." *See* Specification, p. 2, lines 19-21. For example, EFT transactions "are convenient to the extent that they do not require customers to physically visit the bank in order to initiate a financial transaction" but suffer from the significant disadvantage that "they are not equipped to accept paper checks as part of the transaction." *See* Specification, p. 1, line 14 to p. 2, line 1. ECP can be used to convert paper checks to electronic transactions but the bank first receives a paper check (bank of first deposit, or BOFD) and captures an electronic image of the check or otherwise convert the check to an electronic transaction for processing through a clearing house and paying bank. *See* Specification, p. 2, lines 6-10. **Thus, the Background of the Invention explains that existing systems cannot be used to allow remote deposit of third party checks *without* physical delivery of the third party check to a BOFD.**

Applicants respectfully submit that the Examiner has not met her burden to "focus on those factors, reasons, and evidence that lead the examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation, or that the scope of any enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims." *See* MPEP § 2164.04 (emphasis in original). Additionally, the Examiner has not provided any "specific technical reasons" in support of this rejection, which are "always required." *See* MPEP § 2164.04. Here, the Examiner states only that "[I]t is unclear in the Specification and the drawings how this limitation takes place without the ACH and automated banking system receiving the physical check by the automated banking system at some point during the transaction and crediting to the customer account process." Final Rejection at ¶ 10, Issue No. 1. Applicants have explained, and provided support in the Specification, that the BOFD receives *data* (rather than the physical check) which can comprise transaction data such as routing number, account number, date written and amount of the conventional check, and *processes the discrete value* of the conventional check for deposit.

As noted, while the Examiner states that the inventions are not enabled, she notes that "under the broadest reasonable interpretation, the check is deposited through an on-line banking environment by simply logging into the system and entering the routing information, the amount

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of the deposit, an electronic signature, etc." *Id.* Applicants respectfully submit that this is the distinction that – as stated, in claims 15, 21 and 55, the BOFD receives *data* (rather than the physical check) which can comprise transaction data such as routing number, account number, date written and amount of the conventional check, and *processes the discrete value* of the conventional check for deposit. *See* claims 15, 21, 55. The physical check remains with the customer.

Finally, the Examiner states that "[a]ccording to the discussion on page 14, the check does go through a clearing process." Final Rejection at ¶ 10, Issue No. 1. Applicants are unclear what "Page 14" refers to. Page 14 of the application is the Abstract, and it does not refer to a clearing process for a check. Applicants have reviewed Page 14 of the Response to Restriction Requirement dated July 28, 2005 and the Amendment and Response to the Office Action dated September 20, 2005 and can find no reference to a clearing process for a check. Applicants would respectfully request that if the Examiner maintains this basis for this rejection that she inform undersigned counsel in writing or by telephone exactly what "Page 14" references.

Accordingly, Applicants respectfully submit that this rejection should be withdrawn because (1) Applicants have provided six different citations in the Specification which provide enablement for the claimed inventions that the **value** of a physical check is deposited **without receipt of the physical check by the BOFD**; and (2) the Examiner has not met the initial burden of establishing a reasonable basis to question the enablement provided for the claimed invention. *See* MPEP § 2164.04 ("In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention," *citing In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure)).

III.   Rejections Under 35 U.S.C. § 103(a).

Claims 15, 17 and 55 have been rejected as allegedly unpatentable under 35 U.S.C. § 103(a) over to Zeanah in view of Gustin, Josephson and Geer. *See* Final Rejection at ¶ 7. Claims 21, 56-58, 64, 65 and 68-76 have been rejected as allegedly unpatentable under 35 U.S.C.

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§ 103(a) over Josephson and Gustin in view of Geer. *See* Final Rejection at ¶ 9. Applicants respectfully submit that the cited references do not provide any motivation for combining the references to form the invention claimed in claims 15, 17, 21, 55-58, 64 and 65 and therefore do not form a *prima facie* case of obviousness. Additionally, even a combination of the references does not teach each and every limitation of the inventions of claims 15, 17, 21, 55-58, 64 and 65. Accordingly, Applicants respectfully submit that this rejection should be withdrawn. Applicants further note that the Examiner agrees that disclosure of limitations 15(d), 21(d) and 55(d) (the value of a conventional check is deposited from a customer's remote terminal without the ACH and automated banking system receiving the physical check) are "questionable until clarification of how the conventional check is deposited without ever physically receiving the physical check by the automated banking system and without the ACH ever receiving the physical check . . ." Final Rejection at ¶ 10, Conclusion.

A. Claims 15, 17 and 55.

Claims 15, 17 and 55 have been rejected as allegedly unpatentable under 35 U.S.C. § 103(a) over Zeanah in view of Gustin, Josephson and Geer. *See* Final Rejection at ¶ 7. Applicants respectfully submit that there is no motivation in the cited references to combine the teachings therein, and therefore do not form a *prima facie* case of obviousness. Further, Applicants respectfully submit that the combination of Zeanah, Gustin, Josephson and Geer does not disclose each and every limitation of claims 15, 17 and 55.

The Examiner asserts, with respect to claim 15, that Zeanah and Gustin teach "(a) logging a bank customer payee onto an automated banking system through a customer terminal that is remotely situated with respect to a bank, and the automated banking system." Final Rejection at ¶ 7. The Examiner further asserts that Gustin also teaches "(b) receiving transaction data that was entered into the customer terminal by the bank customer payee, wherein the transaction data comprises routing number, account number, date written and amount of the conventional check." *Id.* Examiner yet further asserts that Josephson teaches "(e) receiving by the bank customer a result of the transaction for each check (col. 8, lines 34-40 and lines 49-57)." *See* Final Rejection at ¶ 7. The Examiner finally asserts that Geer teaches "(d) processing the discrete value of each

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check for deposit by the automated banking system without physical receipt of the conventional

check by the automated banking system (col. 6, lines 40 - col. 7, line 61 and col. 8, lines 1-27)."

Id. The Examiner concludes that it "would have been obvious to one having ordinary skill in the

art at the time the invention was made to log the bank customer payee onto an automated

banking system from a customer terminal that is remotely situated with respect to a bank and the

automated banking system and to modify Josephson because such a modification would allow

Josephson to have a secure customer terminal for transacting business in an automated banking

system." *Id.*

1. Modifying Zeanah with the teachings of Gustin, Josephson and Geer constitutes improper hindsight.

Applicants respectfully submit that there is no motivation in Zeanah to modify it with the

teachings of Gustin, Josephson and Geer, and so the proposed combination here constitutes

improper hindsight. *See* MPEP § 2143 ("In determining the propriety of the Patent Office case

for obviousness in the first instance, it is necessary to ascertain whether or not the reference

teachings would appear to be sufficient for one of ordinary skill in the relevant art having the

reference before him to make the proposed substitution, combination or other modification,"

citing In re Linter, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972)). This motivation

must be either explicit or implicit. *See* MPEP § 2143. "The test for an implicit showing is what

the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the

problem to be solved as a whole would have suggested to those of ordinary skill in the art,"

citing In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). "The mere

fact that references <u>can</u> be combined or modified does not render the resultant combination

obvious unless the prior art also suggests the desirability of the combination." *See* MPEP §

2134, *citing In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). (emphasis in original).

Specifically, when a primary reference is missing elements, the law of obviousness

requires that the Office set forth some motivation why one of ordinary skill in the art would have

been motivated to modify the primary reference in the exact manner proposed. *See Ruiz v. A.B.

Chance Co.*, 234 F.3d 654, 664 (Fed. Cir. 2000). In other words, there must be some recognition

that the primary reference has a problem and that the proposed modification will solve that exact

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problem. All of this motivation must come from the teachings of the prior art to avoid impermissible hindsight looking back at the time of the invention.

In the present case, the sole justification for modifying Zeanah has absolutely nothing to do with any deficiencies of Zeanah. Zeanah discloses a delivery system and method that allows a financial institution to provide financial services to a plurality of remote devices, such as personal computers, personal data assistants and screen phones. *See* Abstract. The invention of Zeanah is a single base for interfacing with all types of remote devices, allowing bank customers to access banks from a variety of remote devices or from other countries while reducing the complexity required of the bank's internal computer system. *See* col. 2, line 4- col. 3, line 23; col. 3, lines 39-48. Also, Zeanah reduces the amount of testing that is required for modifications to the applications that govern the bank's internal computer system. *See* col. 3, lines 24-48. Zeanah discloses an interface between a bank and a customer's personal computer for performing transactions from a customer's home that are known in the art, such as bill paying and money transfers. *See* col. 1, lines 58-63.

Here, the Examiner has the burden to show a suggestion or motivation found somewhere in the prior art regarding the *desirability* of the modification *of Zeanah*. *See* MPEP § 2143.01; *see also In re Mills*, 16 USPQ2d at 1432; *In re Fritz*, 23 USPQ2d 1780 (Fed. Cir. 1992). Any such motivation here is completely lacking. Applicants submit that modifying Zeanah with the teachings of Gustin, Josephson and Geer would not remedy any deficiencies found in Zeanah. Zeanah discloses a system for allowing a financial institution to provide financial services to a plurality of remote devices. *See* Abstract. There is no perceived problem in Zeanah regarding a need for a system and method for remote customers to deposit conventional checks without physical receipt of the conventional checks by the automated banking system.

In support of this rejection, the Examiner states that "such a modification would allow *Josephson* to not have physical paper checks transported from the bank customer's location and to have the information from the checks extracted and converted into electronic form." Final Rejection at ¶ 7 (emphasis added). However, the law requires that the justification for combining references must be to modify the *primary reference* in the exact manner proposed.

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See Ruiz, 234 F.3d at 664. Here, the Examiner provides no justification for modifying the primary reference, *Zeanah*. In fact, the disclosures of Zeanah and Gustin do not pertain to the deposit of checks at all, which is an additional reason why there is no motivation to combine these references with Josephson and Geer. Therefore, this is a clear example of improper hindsight. This rejection should be withdrawn for this reason alone.

In addition, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Here, the combination of Zeanah with the cited elements of Gustin, Josephson and Geer would not result in the claimed invention at least for the reason that Zeanah does not relate to the deposit of checks at all, and thus displays no deficiencies in this regard.

Applicants therefore respectfully request that this rejection be withdrawn. Since claim 55 was rejected for the similar rationale as claim 15, the rejection of claim 55 should be withdrawn for the same reasons. *See* Final Rejection at ¶ 7.

2. The improper combination of Zeanah, Gustin, Josephson and Geer does not teach each and every limitation of claim 15.

Additionally, the improper combination of Zeanah, Gustin, Josephson and Geer does not teach each and every limitation of claim 15. Specifically, the combination of these references does not teach at least limitation claim 15(d) of processing the discrete value of each check for deposit by the automated banking system without physical receipt of the conventional check by the automated banking system. The Examiner cites to Geer at col. 6, lines 40 - col. 7, line 61 and col. 8, lines 1-27 as allegedly disclosing this limitation. Applicants respectfully disagree. This cited section of Geer discloses check and payment stub processing by business payees who receive large numbers of checks from numerous customers. *See* col. 1, lines 36-40; col. 6, lines 50-53. The payees compile information from received checks as part of their accounting process when reconciling payments with customer invoices. *See* col. 7, lines 19-26. The compiled information is transmitted to a depositing bank. *See* col. 9, lines 14-17. There is no disclosure in Gustin of a method or system for depositing the discrete value of a single conventional check that is payable to a bank customer payee. Applicants note that the Examiner concedes that it is

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"questionable" that the cited references disclose this limitation. *See* Final Rejection at ¶ 10, Conclusion.

For this additional reason. Applicants respectfully submit that these references do not support a *prima facie* case of obviousness and request that this rejection be withdrawn.

3. Claims 17, 55 and 68-70 are not unpatentable under 35 U.S.C. § 103(a).

Claims 17 and 68-70 are dependent from claim 15 so the rejection of claim 17 should be withdrawn for the same of reasons as for claim 15. Since claim 55 was rejected for the similar rationale as claim 15, the rejection of claim 55, and dependent claims 74-76,[1] should be withdrawn for the same reasons. *See* Final Rejection at ¶ 7.

B. Claims 21, 64, 65, and 71-73.

Claims 21, 64, 65 and 71-73 have been rejected as allegedly unpatentable under 35 U.S.C. § 103(a) over Josephson and Gustin in view of Geer. *See* Final Rejection at ¶ 9. Applicants respectfully submit that the combination of Josephson, Gustin and Geer does not disclose each and every limitation of claims 21, 64, 65 and 71-73, and therefore do not form a *prima facie* case of obviousness. Further, Applicants respectfully submit that there is no motivation in the cited references to combine the teachings therein.

The Examiner asserts with respect to claim 21 that "Josephson teaches, A computerized for allowing a bank to process check deposit transactions that are initiated by a bank customer at a remote location, comprising: (a.) receiving a request from a bank customer on a terminal that is remotely situated from a bank for authorization to make a transaction using an automated banking system, wherein the terminal is remotely situated from the automated banking system (col. 4, lines 56-65 and col. 5, lines 26-63 and fig. 1)." *See* Final Rejection at ¶ 9. The Examiner asserts that Gustin teaches "authorizing a bank customer payee as a user on the automated banking system (fig. 8 (300, 308 & 310), fig. 8A, and fig. 8B - shows authorizing a customer

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[1] Applicants note that the Examiner has rejected claims 56-58 and 74-76 for the same rationale as claim 21. *See* Final Rejection at ¶ 9. Applicants note that these claims are dependent from claim 55, and the rejections of these claims should be withdrawn for the same reasons as for claim 55.

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payee as a user of the automated banking system)); and (c.) receiving transaction data related to the deposit of a conventional check payable to the bank customer, where the payor is someone other than the bank customer (col. 12, lines 3-47, col. 19, line 56 - col. 20, line 63, Fig. 13E, Fig. 13F, fig. 20, fig. 20A, Fig. 20B, fig. 20C, Fig. 20E, and Fig. 20F)." *See id.* The Examiner further asserts that Geer teaches "(d.) processing the transaction for the discrete value of each check without physical receipt of the conventional check by the automated banking system (col. 6, lines 40- col. 7, line 61 and col. 8, lines 1-27)." *See id.* The Examiner concludes that it "would have been obvious to one having ordinary skill in the art at the time the invention was made to log the bank customer payee onto an automated banking system from a customer terminal that is remotely situated with respect to a bank and the automated banking system and to modify Josephson because such a modification would allow Josephson to not have physical paper checks transported from the bank customer's location and to have the information from the checks extracted and converted into electronic form." *Id.*

1. Modifying Josephson with the teachings of Geer and Gustin constitutes improper hindsight.

Applicants respectfully submit that there is no motivation in Josephson to modify it with the teachings of Geer and Gustin, and so the proposed combination here constitutes improper hindsight for the same reasons stated previously for claim 15. Again, the Examiner has not shown a perceived problem with Josephson that would be corrected by the teachings of Geer and Gustin.

Applicants respectfully submit that there is no motivation found in Josephson to modify it by the teachings of Geer and Gustin to "allow Josephson to not have physical paper checks transported from the bank customer's location and to have the information from the checks extracted and converted into electronic form" because there is no such perceived problem in Josephson. Josephson discloses an electronic system and method for providing advance notification of a potential return that may occur when a presenting financial institution ("FI") eventually presents an item for payment to a paying FI in a subsequent paper-based presentment process. *See* Abstract. The invention addresses deficiencies of the prior art, for example the delay that occurs between the time a check is deposited at a sending FI and the time the paying

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FI pays the money to the sending FI. *See* col. 2, lines 28-33. During this delay, the sending FI must either place a hold on the check depositor's account for the amount of the check, or else incur the risk that the paying FI will reject the check. *See* col. 2, lines 31-36. However, federal law imposes time limits on the length of time a sending FI can retain a hold on depositor's funds. *See* col. 2, lines 40-45. The invention addresses these deficiencies by maintaining a database of restricted account data. *See* col. 4, lines 24-27. When a sending FI captures item data from an item, such as a deposited check, the item data are checked against the restricted account data to determine whether the item is drawn on an account that the paying FI has restricted. *See* col. 4, lines 27-31.

Thus, Josephson addresses the problem incurred by a FI to reduce the delay that occurs between the time beginning *after* a check is deposited at a sending FI and the time the paying FI pays the money to the sending FI. Josephson solves this problem by maintaining a database of restricted account data *at the FI*. The sole justification for combining these references stated in the Final Rejection, however, is to "allow Josephson to not have physical paper checks transported from the bank customer's location and to have the information from the checks extracted and converted into electronic form." Josephson, however, does not suggest that there is a problem in the manner of having physical paper checks transported from the bank customer's location and having information from the checks extracted and converted into electronic form in the first instance. Rather, the problem in Josephson to be solved occurs only *after* a check has been deposited with the sending FI, which is to reduce the delay that occurs between the time beginning *after* a check is deposited at a sending FI and the time the paying FI pays the money to the sending FI. Allowing customers to have physical checks transported from the bank customer's location to the sending FI and to have information form the checks extracted and converted into electronic form bears no relation to reducing the delay between deposit of a check with the sending FI and the time money is sent from the paying FI to the sending FI. Applicants respectfully submit that there is no motivation found in Josephson to modify it by the teachings of Geer and Gustin to "have physical paper checks transported from the bank customer's location and to have the information from the checks extracted and converted into

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electronic form" because there is no perceived problem in Josephson that would require physical
paper checks to be transported from the bank customer's location or to have the information
from the checks extracted and converted into electronic form. Accordingly, there is no
motivation in Josephson to modify it with the teachings of Geer and Gustin at all, and the
combination in forming this rejection constitutes improper hindsight.

Applicants therefore respectfully request that this rejection be withdrawn.

2. The improper combination of Josephson, Geer and Gustin does not teach each and every limitation of claim 21.

Additionally, the improper combination of Josephson, Geer and Gustin does not teach
each and every limitation of claim 21. Specifically, the combination of these references does not
teach at least limitation claim 15(d) of processing the discrete value of each check for deposit by
the automated banking system without physical receipt of the conventional check by the
automated banking system. The Examiner cites to Geer at col. 6, lines 40 - col. 7, line 61 and
col. 8, lines 1-27 as allegedly disclosing this limitation. Applicants respectfully disagree.
discloses check and payment stub processing by business payees who receive large numbers of
checks from numerous customers. *See* col. 1, lines 36-40; col. 6, lines 50-53. The payees
compile information from received checks as part of their accounting process when reconciling
payments with customer invoices. *See* col. 7, lines 19-26. The compiled information is
transmitted to a depositing bank. *See* col. 9, lines 14-17. There is no disclosure in Gustin of a
method or system for depositing the discrete value of a single conventional check that is payable
to a bank customer payee. Applicants note that the Examiner concedes that it is "questionable"
that the cited references disclose this limitation. *See* Final Rejection at ¶ 10, Conclusion.

For this additional reason. Applicants respectfully submit that these references do not
support a *prima facie* case of obviousness and request that this rejection be withdrawn

3. Claims 71-73 are not unpatentable under 35 U.S.C. § 103(a).

Finally, since claims 71-73 are dependent from claim 21, these claims should not be
rejected under 35 U.S.C. § 103(a) similar rationale.

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CONCLUSION

Applicants respectfully submit that claims 15, 17, 21, 55-58, 64, 65 and 68-76 are in condition for allowance and request allowance of the same.
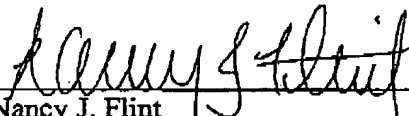
This Amendment After Final Rejection has been filed within two months of the mailing date of the Final Rejection and Applicants believe that no fees are due upon filing. If any fees are determined to be due, the Commissioner is hereby authorized to deduct such fees from the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

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